

REMARKS

Claims 10-24 are in the case. Claims 1-9 are cancelled. Claims 17-24 are new.

The courtesies extended by Examiner Ralph Lewis in discussing the present application with attorney for Applicant, Brian L. Belles, on August 31, 2005 are noted appreciation. During the interview, Mr. Belles discussed the possibility of submitting Affidavits under Rule 132 to rebut the obviousness rejections of claims 10 and 13 by showing commercial success and long felt need. Examiner Lewis stated that such evidence is accordance with the law to rebut prima facie obviousness and instructed Mr. Belles to submit the evidence he deemed relevant. This Response and the attached Affidavits are being filed accordingly.

Cancellation of Claims 1-9

In order to expedite prosecution of the present application, claims 1-9, which were directed to an apparatus for removing a removable tooth positioning appliance from the teeth of a patient, are cancelled. Applicant reserves the right to prosecute these claims in a continuing application at the appropriate time.

Rejections Under 35 U.S.C. § 112

On page 2 of the Office Action, claims 14 and 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 14 and 15 were rejected because "there is no antecedent basis of '[t]he method'" in the preamble.

Claim 14 has been amended to depend on claim 13 rather than claim 1. The original dependency of claim 14 on claim 1 was inadvertent. It is believed that the lack of antecedent basis for "the method" is remedied. Accordingly, it is respectfully requested that the rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 102

On page 2 of the Office Action, claims 1-9 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 2,602,998 ("Sprague").

The rejection of claims 1-9 under 35 U.S.C. § 102(b) over Sprague is mooted in view of the cancellation of these claims. The rejection of claim 14 under 35 U.S.C. § 102(b) over Sprague is also mooted in view of its dependency being amended from claim 1 to claim 13.

Rejections Under 35 U.S.C. § 103

On page 3 of the Office Action, claims 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's Figure 1 admission of prior art in view of United States Patent 2,602,998 ("Sprague"). Specifically, the Office Action states that "[a]pplicant admits that tooth positioning appliances as that illustrated in Figure 1 for aligning the teeth of a patient are known prior art." While the Office Action further acknowledges that the "admitted prior art fails to disclose a tool for removing the appliance," it asserts that "if the time came when it was time to remove the device and it was stuck or difficult to remove by hand, then one of ordinary skill in the art, would have found it obvious to have looked to the prior art dental tools for a device to aid in the removal of dental appliances." The Office Action further notes that "Sprague teaches a very similar item to aid in removing tightly secured partial dentures from a patient's mouth" and that it would have been obvious to one skilled in the art "[t]o have used the Sprague tool to also remove other known prior art dental appliances from the patient's mouth." This assertions is incorrect.

Admittedly, tooth positioning appliances, such as the one shown in Figure 1 of the present application, are known in the art. However, one skilled in the art of using, applying, adjusting, and prescribing removable tooth positioning appliances would not use the Sprague tool to remove such an appliance. The Sprague tool is designed for the removal of prosthetic dental devices, such as dentures and/or bridges. *See Sprague*, Col. Lines 1-5. Prosthetic dental devices, including their methods of removal, are very different than the removable tooth positioning appliances recited in claims 10 and 13 of the present application. As shown in Sprague, the prosthetic dental device is removed by hooking the sharp point 3 of the Sprague

device 1 on a clasp 4 of the denture/bridge 5. *See Sprague*, Column 2, Lines 5-50. In contrast, the tooth positioning appliance recited in claims 10 and 13 of the present application are removed by engaging an edge/rim of the tooth positioning appliance and inserting the tapered edge of the apparatus between the tooth positioning appliance and the teeth of the patient.

Thus, unlike the removal of prosthetic dentures/bridges that utilizes a clasp as shown in *Sprague*, removal of tooth positioning appliances require that the tapered edge of the apparatus be located in a position that is prone to damaging the teeth and/or gums of the patient. If the *Sprague* tool was used to remove tooth positioning appliances as asserted in the Office Action, the sharp/point 3 of the *Sprague* tool could cause serious damage to a user's gums/teeth. As a result, one skilled in the art would not use the *Sprague* tool to remove a removable tooth positioning appliance, as is required by claim 13. Additionally, one skilled in the art would not distribute the *Sprague* tool in combination with (or for use with) a removable tooth positioning appliance, as is required by claim 10.

Therefore, it is applicant's position that rejection of claims 10 and 13 under 35 U.S.C. § 103 over Figure 1 in view of *Sprague* is improper and should be withdrawn.

Finally, even if the position is maintained that the rejection of claims 10 and 13 under 35 U.S.C. § 103 over Figure 1 in view of *Sprague* is a proper prima facie case of obviousness, Applicant submits herewith evidence to rebut this position. Specifically, Applicant submits contemporaneously herewith evidence of commercial success and long felt need in the form of: (1) an Affidavit under Rule 132 from Dr. Orhan C. Tuncay attached hereto as Exhibit A; (2) an Affidavit under Rule 132 from Dr. Wm. Randol Womack attached hereto as Exhibit B; and (3) an Affidavit under Rule 132 from Dann Schwartz attached hereto as Exhibit C. *See MPEP* §§ 716.03 and 716.04. These affidavits and their accompanying annexes are included herewith for the Examiner's review.

New Claims

Claims 17-24 are new. No new matter is added by these claims.

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It is believed that all grounds of rejection have been traversed or obviated, and that the rejections should be withdrawn, and the application allowed.

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